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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,149	10/27/2003	Sang Hoon Woo		3029

7590 10/19/2005
Sang Hoon Woo
206 OLD DOCK TRAIL
CARY, NC 27519

EXAMINER

MATTHEWS, WILLIAM H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,149

Applicant(s)

WOO, SANG HOON

Examiner

William H. Matthews (Howie)

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31,32 and 34-58 is/are pending in the application.
- 4a) Of the above claim(s) 51-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,32,34-50 and 54-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-15-05, 7-19-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of invention II and species E/BB (Figures 5 and 6) in the reply filed on 6-15-05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 51-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6-5-05. Note Applicant did not list claims 51 and 52 as non-elected, but claims 51 and 52 are drawn to figure 7.

Claim Objections

3. Claim 55 is objected to because of the following informalities: "the opening" in line 4 lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 34-41,43-47,49,50,54 are rejected under 35 U.S.C. 102(e) as being anticipated by Stack et al. US PUB 2005/0004681.

Stack et al. discloses in figure 5 a method of weight loss treatment comprising performing a partial intestinal bypass having an adjustable opening (expandable stent opening) and valves.

6. Claims 34-40,46-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Bessler US PUB 2004/0039452.

Bessler discloses in figures 1-4 a method of weight loss treatment comprising performing a partial intestinal bypass having an adjustable opening and valves.

7. Claims 34-37,41,43,46,49,50,55,57,58 are rejected under 35 U.S.C. 102(e) as being anticipated by Gannoe et al. US PUB 2004/0006351.

Gannoe et al. discloses in figures 4B-5 a method of weight loss treatment comprising performing a partial intestinal region bypass having an adjustable opening and valves. Paragraph 0017 describes adjusting the opening after implantation.

8. Claims 34-37,46,47,49,50,54-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Solomon et al. US PUB 2004/0220516.

Solomon et al. discloses in figure 11 and paragraphs 0055-0062 a method of weight loss treatment comprising performing intestinal bypass using an adjustable pathway (inflation portions, 2 and 20) having valves. Solomon further discloses in paragraph 0062 combining the treatment with diet modification.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stack et al. US PUB 2005/0004681 as applied to claim 34 and 41 above, and further in view of Solomon et al. US PN 2004/0220516.

Stack et al. meets the steps of claim 42 but lacks the express written disclosure of bypassing substantially all of the small intestine. Solomon et al. teach in figure 11 and paragraphs 61-62 a small intestine bypass in order to promote substantial weight loss.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Stack et al. to include an intestinal bypass that bypasses substantially all of the small intestine as taught by Solomon et al. in order to promote substantial weight loss.

11. Claims 31,31,47,54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gannoe et al. US PUB 2004/0006351 as applied to claims 34,36,41, and 46 above, and further in view of Solomon et al. US PN 2004/0220516.

Gannoe et al. meets the steps of claims 31,31,47,54 but lacks the express written disclosure of including evaluation steps to determine adjustment needs of the bypass, using a one way valve, and using the method in conjunction with diet modification. Solomon et al. teach in figure 11 and paragraphs 55-62 a method of inducing weight loss using an intestinal bypass having a valve to prevent reflux, evaluation of electrolyte balance, and providing additional diet modification in order to to maintain proper health during a weight loss program.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Stack et al. to include evaluation steps to determine adjustment needs of the bypass, using a one way valve, and using the method in conjunction with diet modification as taught by Solomon et al. in order to maintain proper health during a weight loss program.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WHM
10-15-05



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